

ESTTA Tracking number: **ESTTA562907**

Filing date: **10/03/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Top Tobacco, L.P.		
Entity	limited partnership	Citizenship	Delaware
Address	2301 Ravine Way Glenview, IL 60025 UNITED STATES		

Attorney information	Antony J. McShane Neal, Gerber & Eisenberg LLP 2 North LaSalle Street, Suite 1700 Chicago, IL 60602 UNITED STATES amcshane@ngelaw.com, afuelleman@ngelaw.com, temanuelson@ngelaw.com Phone:312.269.8000
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### Applicant Information

Application No	85910359	Publication date	09/24/2013
Opposition Filing Date	10/03/2013	Opposition Period Ends	10/24/2013
Applicant	Black Diamond Tobacco, Inc. 7549 West 99th Street Bridgeview, IL 60455 UNITED STATES		

### Goods/Services Affected by Opposition

Class 034. All goods and services in the class are opposed, namely: Hookah tobacco
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2293958	Application Date	11/21/1997
Registration Date	11/23/1999	Foreign Priority Date	NONE
Word Mark	TOP		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 034. First use: First Use: 1900/12/10 First Use In Commerce: 1900/12/10 smoking tobacco		
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U.S. Registration No.	2739465	Application Date	06/20/2000
Registration Date	07/22/2003	Foreign Priority Date	NONE
Word Mark	TOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 1942/01/01 First Use In Commerce: 1942/01/01 cigarette rolling papers		

U.S. Registration No.	2739466	Application Date	06/20/2000
Registration Date	07/22/2003	Foreign Priority Date	NONE
Word Mark	TOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 1900/12/10 First Use In Commerce: 1900/12/10 smoking tobacco		

U.S. Registration No.	2831105	Application Date	04/26/2000
Registration Date	04/13/2004	Foreign Priority Date	NONE
Word Mark	TOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 1942/01/01 First Use In Commerce: 1942/01/01 cigarette rolling papers		

U.S. Registration No.	3407400	Application Date	02/08/2006
Registration Date	04/01/2008	Foreign Priority Date	NONE
Word Mark	TOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 2004/11/30 First Use In Commerce: 2004/11/30 cigarette making machines Class 034. First use: First Use: 1900/12/10 First Use In Commerce: 1900/12/10 Cigarette rolling paper booklets; roll-your-own smoking tobacco; cigarette rolling machines; cigarette tubes; injector machines for filling cigarette tubes for personal use; filter tips for cigarettes; roll-your-own kits for cigarettes containing		

	cigarette rolling papers, filter tips and tobacco		
U.S. Registration No.	3720176	Application Date	03/29/2006
Registration Date	12/01/2009	Foreign Priority Date	NONE
Word Mark	TOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2007/07/06 First Use In Commerce: 2007/07/06 Tobacco		
U.S. Registration No.	3677986	Application Date	03/29/2006
Registration Date	09/01/2009	Foreign Priority Date	NONE
Word Mark	TOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2006/07/00 First Use In Commerce: 2006/07/00 cigarette rolling papers		
U.S. Registration No.	3677987	Application Date	03/29/2006
Registration Date	09/01/2009	Foreign Priority Date	NONE
Word Mark	TOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2006/07/00 First Use In Commerce: 2006/07/00 Cigarette rolling papers		
U.S. Registration No.	3710606	Application Date	03/29/2006
Registration Date	11/10/2009	Foreign Priority Date	NONE
Word Mark	TOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2007/07/06 First Use In Commerce: 2007/07/06 Tobacco		
U.S. Registration No.	3918139	Application Date	11/06/2009
Registration Date	02/08/2011	Foreign Priority Date	NONE

Word Mark	TOP
Design Mark	
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 1992/03/27 First Use In Commerce: 1992/03/27 pocket machines for rolling cigarettes for personal use

U.S. Registration No.	3029855	Application Date	01/07/2004
Registration Date	12/13/2005	Foreign Priority Date	NONE
Word Mark	TOP-O-MATIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2004/11/30 First Use In Commerce: 2004/11/30 Cigarette rolling machines		

Attachments	Notice_of_Opposition_re_TOP_SECRET.pdf(13836 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Antony McShane/
Name	Antony J. McShane
Date	10/03/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application	)	
	)	
Serial No.: 85/910,359	)	
	)	
TOP TOBACCO L.P.,	)	
	)	
Opposer,	)	<b>NOTICE OF OPPOSITION</b>
v.	)	
	)	
BLACK DIAMOND TOBACCO, INC.,	)	
	)	
Applicant.	)	

This Notice of Opposition is submitted in the matter of Application Serial No. 85/910,359 for registration by Black Diamond Tobacco, Inc. of the term TOP SECRET based upon its intent to use that term in connection with “hookah tobacco” in International Class 34, which was published for opposition in the Official Gazette on September 24, 2013. Top Tobacco L.P., a Delaware limited partnership, having a place of business at 2301 Ravine Way, Glenview, Illinois 60025, believes that it would be damaged by the registration and therefore opposes the same.

The grounds for Opposition herein are as follows:

1. For many years, and long before the acts of Applicant alleged herein, Top Tobacco, including its predecessors and affiliates (“Top Tobacco”), has been engaged, *inter alia*, in the manufacture, distribution and sale of smokers’ articles, including tobacco, cigarette rolling papers, cigarette filters, cigarette tubes, and cigarette rolling, injector and making machines, which are distributed throughout the United States through tobacco shops, drugstores, tobacco outlets, convenience and other retail stores.

2. For many years, and long prior to the acts of Applicant alleged herein, Top Tobacco has distributed and sold, and continues to distribute and sell tobacco, cigarette rolling papers, cigarette filters, cigarette tubes, and cigarette rolling, injector and making machines under and in connection with the trademark TOP.

3. Top Tobacco has devoted substantial resources, time and effort in developing, marketing and distributing such goods under its TOP mark. As a result of Top Tobacco's consistent efforts to promote and protect its TOP mark, Top Tobacco has developed considerable recognition and goodwill in the TOP mark, which is now widely recognized as signifying Top Tobacco and its goods.

4. The TOP mark is now among Top Tobacco's most valuable assets. To protect its rights in the mark, Top Tobacco has obtained the following federal registrations for the TOP, TOP and Design, and TOP-O-MATIC marks for use in connection with tobacco, cigarette rolling papers, cigarette filters, cigarette tubes, and cigarette rolling, injector and making machines, some of which are incontestable pursuant to 15 U.S.C. § 1065:

<b>Mark</b>	<b>Goods</b>	<b>Registration No.</b>	<b>Registration Date</b>
TOP and Design	smoking tobacco	2,293,958	Nov. 23, 1999
TOP and Design	cigarette rolling papers	2,739,465	July 22, 2003
TOP	smoking tobacco	2,739,466	July 22, 2003
TOP	cigarette rolling papers	2,831,105	April 13, 2004
TOP	cigarette rolling paper; smoking tobacco; cigarette rolling machines; cigarette tubes; cigarette injector machines; cigarette filter tips; kits for making cigarettes containing cigarette rolling papers, filter tips and tobacco	3,407,400	April 1, 2008

<b>Mark</b>	<b>Goods</b>	<b>Registration No.</b>	<b>Registration Date</b>
TOP and Design	tobacco	3,720,176	Dec. 1, 2009
TOP and Design	cigarette rolling papers	3,677,986	Sept. 1, 2009
TOP and Design	cigarette rolling papers	3,677,987	Sept. 1, 2009
TOP and Design	tobacco	3,710,606	Nov. 10, 2009
TOP	cigarette rolling machines	3,918,139	February 8, 2011
TOP-O-MATIC	cigarette rolling machines	3,029,855	Dec. 13, 2005

5. On April 22, 2013, long after Top Tobacco began use of its TOP mark, Applicant filed an application to register the term TOP SECRET based upon its intent to use the term in connection with “hookah tobacco,” in International Class 34, Serial No. 85/910,359.

6. The TOP SECRET mark that Applicant seeks to register is confusingly similar to Top Tobacco’s TOP mark. As a result of the similarity of the parties’ marks, the similarity of the goods associated with the marks, and the strength of Top Tobacco’s TOP mark, Applicant’s use and registration of the TOP SECRET mark is likely to cause confusion or mistake, or to deceive purchasers, in that purchasers would be likely to believe that Applicant’s goods are Top Tobacco’s goods, or are in some way legitimately connected with, sponsored by, or approved by Top Tobacco in violation of 15 U.S.C. § 1052(d). Applicant’s registration of the term TOP SECRET would, therefore, damage Top Tobacco, and on that basis, Top Tobacco opposes registration of the mark by Applicant.

WHEREFORE, Top Tobacco requests that the registration sought by Applicant be refused and that this Notice of Opposition be sustained.

Respectfully submitted,

Date: October 3, 2013

By: /Antony J. McShane/  
One of the Attorneys for Top Tobacco L.P.

Antony J. McShane  
Andrea S. Fuelleman  
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**CERTIFICATE OF SERVICE**

I, Andrea S. Fuelleman, state that I served a copy of the foregoing Notice of Opposition  
upon:

Erik M. Pelton  
Erik M. Pelton & Associates, PLLC  
P.O. Box 100637  
Arlington, Virginia 22210-3637

via First Class U.S. Mail on October 3, 2013.

/Andrea S. Fuelleman/

NGEDOCs: 2120536.1